

REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the above amendments and in light of the following discussion is respectfully requested.

Claims 1, 2, 4-11, 13 and 15-19, 21, 23 and 27 are pending in the present application. Claim 27 is added, Claims 20 and 22 are cancelled without prejudice or disclaimer and Claims 1, 13, 15-19, 21 and 23 are amended by the present response. No new matter is introduced.

In the outstanding Office Action, Claims 13 and 15-22 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter; Claims 1, 4-10, 15-20 and 22 were rejected under 35 U.S.C. §102(e) as anticipated by Matsushima (U.S. Pat. Pub. No. 2002/0144257); and Claims 2, 11, 13, 21 and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Matsushima in view of Washino (U.S. Patent No. 5,537,157).

With regard to the rejection of Claims 13 and 15-22 under §101, as directed to non-statutory subject matter, independent Claim 22 has been cancelled by the present response. Accordingly, Applicants respectfully submit that the rejection of these claims is moot. In addition, Applicants respectfully submit that new Claim 27, from which Claims 13 and 15-19 and 21 depend, recites a non-transitory computer readable medium claim. Accordingly, Applicants respectfully request that the rejection of Claims 13 and 15-22 under §101, be withdrawn.

Addressing now the rejection of Claim 1, 4-10, 15-20 and 22 under 35 U.S.C. §102(e) as anticipated by Matsushima, Applicants respectfully traverse this rejection.

Claim 1 recites,

An image forming apparatus to which applications can be added, the image forming apparatus comprising:
an auxiliary storage interface part configured to interface with an auxiliary storage device that stores one or more applications such that the one or more applications are

installed on the auxiliary storage device, and that stores an execution command;

a part configured to display a setting screen that receives launch selection information from a display part of the image forming apparatus, and to store information input via the setting screen as launch selection information, the launch selection information identifying at least the auxiliary storage device from among a plurality of kinds of auxiliary storage devices; and

an application launch part configured to access the launch selection information, and to launch the one or more applications from the auxiliary storage device based on the accessed launch selection information by issuing the execution command which is stored in the auxiliary storage device.

Claim 27 recites similar features and Claim 23 recites at least the above noted features.

Matsushima describes a multifunction machine which executes software downloaded into the multifunction machine.

However, Matsushima does not describe or suggest, at least, that the application launch part launches the one or more applications from the auxiliary storage device based on the accessed launch selection information by issuing the execution command which is stored in the auxiliary storage device.

In the Advisory Action mailed August 17, 2010, the outstanding Action appears to assert that since certain features of the claim were not explicitly recited as one of the claimed elements, these features would not be given patentable weight. Specifically, the outstanding Action appears to assert that only the application launch part itself and the part configured to display and store information would be given weight. Although, Applicants strongly disagree with the position taken in the Advisory Action of August 17, 2010 based on the legal principles noted in *In re Nuijten*, 500 F.3d 1346, 1351, 84 USPQ2d 1495, 1498 (Fed. Cir. 2007) which stands for the principle that the functional characteristics of data that is stored on a medium must be given patentable weight, as well as *In re Swinehart* 439 F.2d 210, 169 USPQ 226 (CCPA 1971)) which asserts that functional limitations “*must be*

evaluated and considered, just like any other limitation of the claim” (emphasis added).

Nevertheless, in order to further prosecution, Applicants have amended the independent claims to explicitly recite certain features of the claims, such as, the auxiliary storage interface part.

The outstanding Action appears to associate the “browser application” 135 with the claimed “application launch part.” Furthermore, the outstanding Action appears to have associated the claimed “one or more applications” with “the application plug-in for downloading the software.” In addition, the outstanding Action asserts that the claimed “auxiliary storage device” corresponds to the external “server 20” of Matsushima.

In response, Applicants note that the claimed invention recites that the one or more applications are launched from the auxiliary storage device based on the accessed launch selection information by issuing the execution command which is stored in the auxiliary storage device. In contrast, the “the application plug-in for downloading the software” of Matsushima is ***not launched from the server 20 or by executing a command which is stored on the server 20.***

Moreover, the outstanding also appears to assert that the claimed execution command corresponds to the steps of “requesting authentication, accessing to the target URL and downloading the software components” of Matsushima.

In response, Applicants note that the claimed invention recites that the execution command is stored in the auxiliary storage device. In contrast, the ***commands executing*** the steps of “requesting authentication, accessing to the target URL and downloading the software components” ***are not stored in the server 20.***

In addition, the Matsushima reference fails to describe or suggest an auxiliary storage interface part configured to interface with an auxiliary storage device that stores one or more

applications such that the one or more applications are installed on the auxiliary storage device, and that stores an execution command.

As is noted above, the outstanding Action asserts that the auxiliary storage device corresponds to the server 20. However, Applicants respectfully submit that Matsushima does not describe or suggest that the server 20 stores one or more applications which are installed therein as well as an execution command.

As was noted in the previous response, “a rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.” See *In re Buszard*, 504 F.3d 1364, 1366 (Fed. Cir. 2007) (quoting *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994)). In the present case, the cited Matsushima reference clearly ***does not disclose each and every limitation of the claimed invention***.

In addition, although the outstanding Action has rejected the claims under 35 U.S.C. §102(e), the Action provides comments consistent with a §103(a) rejection. Specifically, the outstanding Action on pages 3-4 asserts that

one skill[ed] in the art realized that a network can have multiple devices, i.e. servers, computers and their peripherals such [as] printers and copier machines connected as shown in Figs. 10A-B, 14 and 15 etc., thus downloading a software component from Server 20 implies downloading an application from among a plurality of kinds of auxiliary devices.

This language implies that although the cited Matsushima reference does not explicitly describe a plurality of kinds of auxiliary storage devices, it would be obvious to implement such a configuration based on the disclosure of Matsushima.

Moreover, it is well established that ambiguous showings subject to different interpretations (here whether a plurality of kinds of auxiliary storage devices are disclosed in Matsushima) cannot be relied upon to establish anticipation. See, e.g., *In re Turlay*, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962). In order to establish ***anticipation***, there must be clear and unequivocal disclosure by the reference, not just unsupported conclusions as to

what the reference might have been suggesting. See *In re Hughes*, 145 USPQ 467, 471 (CCPA 1965) and *In re Moreton*, 129 USPQ 227, 230 (CCPA 1961).

Thus, Applicants respectfully submit that Claim 1, and similarly Claims 22, and claims depending respectfully therefrom, patentably distinguish over Matsushima considered individually or in any combination.

Accordingly, Applicants respectfully request that the rejection of Claims 1, 4-10, 15-20 and 22 under 35 U.S.C. §102(e), be withdrawn.

Furthermore, with regard to Claim 23, Applicants respectfully submit that this claim patentably distinguishes over Matsushima and Washino considered individually or in combination for at least the reasons noted above with regard to Claim 1 (which also apply to Claim 23), as Washino does not cure the deficiencies of Matsushima with regard to the claimed invention.

In addition, Applicants note that Claim 23 explicitly recites that the auxiliary storage device corresponds to a recording medium removable from the image forming apparatus without disassembling any other portion of the image forming apparatus. The outstanding Action asserts that Washino describes this feature of the claimed invention. However, nothing in Washino describes that launch the one or more applications from the removable recording medium based on the accessed launch selection information by issuing the execution command which is stored in the removable recording medium.

Consequently, for the reasons discussed above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance for Claims 1, 2, 4-11, 13 and 15-23 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

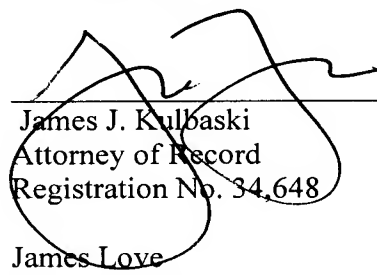
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)



James J. Kulbaski
Attorney of Record
Registration No. 34,648

James Love
Registration No. 58,421

4393334_1